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10/523,866	09/15/2005	Anahit Tataryan	AVERY-70396	1881
47533 7590 08/24/2007 INTELLECTUAL PROPERTY LAW OFFICE OF JOEL VOELZKE 24772 SADDLE PEAK ROAD MALIBU, CA 90265				
			EXAMINER AHMAD, NASSER	
			ART UNIT 1772	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/523,866
Filing Date: September 15, 2005
Appellant(s): TATARYAN ET AL.

MAILED
AUG 24 2007
GROUP 1700

Joel D. Voelzke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/7/2007 and 5/4/2007 appealing from the Office action mailed 9/18/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

It is noted that the heading "STATUS OF AMENDMENT" in the Appeal Brief is directed to "**Status of Amendments After Final**" as explained therein.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.
It is noted that the explanation of the independent claims start in page-6 of the Appeal Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,032,679	AOYAGI	6-1977
3,914,679	STIPEK, Jr.	10-1975
6,170,879	RAWLINGS	1-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-7 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoyagi (4032679).

Aoyagi relates to a multi-removable label construction (figure-2) comprising a facestock layer (21) that is backed with adhesive (22), a cut pattern (24) in the facestock layer that defines a removable sub-label (21a) within said facestock layer, a release liner member (23) that backs and extends beyond said removable sub-label, and that backs less than the entire area of the facestock layer (extends upto numeral 25).

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The sub-label is imprinted and the adhesive is pressure sensitive adhesive (abstract).

Aoyagi also teaches the method for re-using a portion of the label.

As for the presence of mailing information print, it is understood that the presence of printed information (as the sub-label is imprinted) will include mailing information as it is considered to be printed information.

The intended use phrase such as "may be" and the functional phrases '~Nhereby" have not been given any patentable weight because said phrases are not found to be of positive limitations.

Claims 1-2, 6-8, 10-14, 18-19 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Stipek (3914483).

Stipek relates to a multi-removable label construction (figure-1) comprising a facestock layer (17) that is backed with adhesive (19), a cut pattern (23) in the facestock layer that defines a removable sub-label (13) within said facestock layer, a release liner member (25) that backs and extends beyond said removable sub-label, and that backs less than the entire area of the facestock layer (figure-1).

Figure-1 shows that the label is imprinted.

The facestock layer comprises pressure sensitive adhesive coated paper (col. 1, lines 51-54).

The construction of figure-1 shows that the label comprises a plurality of labels.

Further, the multi-label sheet assembly comprises a first removable label (13), a second removable label (41) that is formed within the first removable label (figures 1 and 2).

Stipek also teaches a method of re-using a portion of the label comprising the steps of providing the label, attaching the first label to a first substrate (figure-3), removing at least one second label and attaching it to a second substrate (figure-4).

Regarding the print being mailing information, it is understood by the examiner that the

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presence of printed information of the facestock would include mailing information as it is considered to printed information.

The intended use phrase such as "may be", "to be mailed", etc. and the functional phrases "whereby" have not been given any patentable weight because said phrases are not found to be of positive limitations.

10. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stipek in view of Rawlings (61708790).

Stipek, as discussed above, fails to teach the presence of a second release liner backing the first release liner. Rawlings relates to a piggy-back label construction comprising a first release liner backed by a second release liner as shown in figure-3. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Rawlings' teaching of using a second release liner backing the first release liner in the invention of Stipek with the motivation to provide for re-usability of the label.

Regarding the presence of fourth and fifth line of weaknesses of claim 28, it would have been obvious duplication of parts, absent any showing of criticality by the applicant.

(10) Response to Argument

Appellant argues that it is unclear to the undersigned exactly what the Examiner's position is, but the Examiner appears to be arguing that because Aoyagi discloses printing *something* on his round stickers such as medicine packaging information, that it follows that Aoyagi necessarily discloses printing *any and all possible information* on the stickers including mailing information as claimed by Applicant. That reasoning is not sound. This not deemed to be convincing because, as explained in the Office Action of

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9/18/2006, that the printed information provided in Aoyagi would include mailing information as the mailing information is considered to be printed information.

Appellant is also directed to MPEP 2112.01 (III) which mentions:

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

This further explains that the content of the printed matter does not distinguish the claimed product from prior art of Aoyagi.

Also, with regard to Stipek reference, the above explanations apply a fortiori herein as the arguments are directed to the aspect of mailing information printed in claims 1 and 13.

As for the 103(a) rejection over Stipek in view of Rawlings, appellant should note that Rawlings was cited to show that it is well known and obvious in the art to provide a second release liner for returnable shipping label for its reusability. Responding to appellant's argument that Rawlings relate to a single label construction and not the

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plural label construction as recited in claim 28, appellant is informed that Stipek (the primary reference) teaches the product structure as claimed in claim 28, except for the presence of a second release liner, which is shown to be known in the art by Rawlings. Hence, it would have been obvious to one having ordinary skill in the art to utilize Rawlings' teaching of providing a second release liner backing to the first release liner with the motivation to further re-use the label product, and the presence of the additional line of weakness is found to be obvious duplication of parts, failing any showing of criticality by the applicant.

For appellants' arguments regarding claim 30 and 31, appellant is informed that Aoyagi or Stipek anticipates the claimed structure as explained hereinabove, including the printed information thereon. As for steps of claim 30, appellant's attention is drawn to Aoyagi wherein the drawing (particularly, figure-3 and 4) show that the label can be removed from the liner (23) and adhered to a product (e.g., figure-6), thus reading on claim 30 which recites the steps of providing the facestock sheet, printing information thereon and removing it to adhere it to a first object. For claim 31, Aoyagi also that the inner label can be further removed (as shown in figure-3 and 6) teaching the steps of removing of the inner label and adhering it to another object.

Similarly, the above explanation also apply *a fortiori* regarding claims 30 and 31 with respect to Stipek reference.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Nasser Ahmad 8/15/07

Conferees:


(1) Romulo Delmendo

Appeal Conferee TC1700



(2) Rena Dye

SPE, Art Unit 1772